

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE, a
Washington non-profit corporation,

Plaintiff,

v.

MAURICE KING, LEWIS KING, GLEN
YOSHIOKA, DYLAN WALL, and
AMERICAN MARRIAGE MINISTRIES, a
Washington non-profit corporation,

Defendants.

CASE NO. 2:19-cv-301

REDACTED ORDER ON AMERICAN
MARRIAGE MINISTRIES' MOTION FOR
PARTIAL SUMMARY JUDGMENT ON
ITS COUNTERCLAIMS

AMERICAN MARRIAGE MINISTRIES, a
Washington non-profit corporation,

Counter Claimant,

v.

UNIVERSAL LIFE CHURCH
MONASTERY STOREHOUSE,

Counter Defendants.

This case is about two competitors in the online ordination business. They accuse each other of tortious conduct and various unfair and deceptive business practices under federal and

1 state law. Defendant and Counter-Claimant American Marriage Ministries (“AMM”) moved for
2 summary judgment on Plaintiff and Counter-Defendant Universal Life Church Monastery
3 Storehouse’s (“ULC Monastery”) claims. Dkt. No. 199. The Honorable Richard A. Jones, United
4 States District Judge, granted parts of, and denied parts of, AMM’s motion, but left undecided
5 AMM’s request for summary judgment on its Washington common law trademark infringement
6 and Consumer Protection Act (“CPA”) counterclaims. Dkt. No. 230. The Court now comes back
7 to complete its work, and for the reasons explained below, GRANTS in part, and DENIES the
8 remaining portions of AMM’s motion.

9 BACKGROUND

10 A complete accounting of the factual background of this case can be found in the Court’s
11 prior summary judgment orders. *See* Dkt. Nos. 170, 230. In this order, the Court recounts only
12 the facts relevant to its analysis of AMM’s state law counterclaims, presenting them in the light
13 most favorable to the non-moving party, ULC Monastery.

14 AMM and ULC Monastery provide competing online ordination services for individuals
15 who wish to officiate marriages. AMM Executive Director Lewis King testified that AMM
16 began using the trade name “American Marriage Ministries” upon its incorporation in 2009. Dkt.
17 No. 200 at 2. AMM advertised its services and ordained “[h]undreds of thousands of individuals”
18 under this trade name. *Id.* AMM registered the domain name americanmarriageministries.com in
19 2009. Dkt. No. 115-2 at 25. AMM used americanmarriageministries.com as its primary website
20 until it transitioned its current website, TheAMM.org. *Id.* at 27. AMM allowed its registration for
21 americanmarriageministries.com to lapse and ULC Monastery subsequently registered the
22 americanmarriageministries.com domain name for its own use in July 2011. Dkt. Nos. 115-2 at
23 28; 116 at 3–4. Between 2011 and 2015, ULC Monastery used the
24 www.americanmarriageministries.com site “to redirect internet users to its own website, to

1 maintain a website that masqueraded as AMM, and/or to publish allegedly false . . . information
2 regarding . . . the legal validity of AMM's ordinations." Dkt. No. 170 at 2.

3 In 2014, AMM applied to register the mark "American Marriage Ministries" for use
4 within the ordination services industry. Dkt. No. 115-3 at 51. The United States Patent and
5 Trademark Office ("PTO") rejected AMM's application twice. In 2014, the PTO denied AMM's
6 application under Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(e)(2), finding the mark
7 "primarily geographically descriptive of the origin of [AMM's] services." Dkt. No. 115-3 at 44.
8 In 2015, the PTO maintained its refusal to register under Section 2(e)(2) and found AMM's
9 evidence of acquired distinctiveness insufficient. *Id.* at 14. For its third application, AMM
10 submitted evidence of continuous use of the mark for over five years, that a Google search of the
11 mark generated results that uniformly referred to AMM, and that over 250,000 consumers used
12 AMM's ordination services. Dkt. No. 170 at 9. The PTO registered AMM's mark in January
13 2016 under Section 2(f) of the Lanham Act, which covers acquired distinctiveness. Dkt. No. 115-
14 3 at 2.

15 Beginning in 2018, AMM alleges that ULC Monastery began using the name "American
16 Marriage Ministries" in the visible content of its webpages. Dkt. No. 199 at 5–6. Specifically, on
17 its webpage www.themonastery.org/training/ordination/are-online-ordinations-legal it states:

18 Those who are considering online ordination will possibly still feel unsure and
19 uneasy about the whole concept and process. This makes it a useful exercise to
20 review the legal precedents that have actually been set for the legality of online
21 ordination. The legal history of online ordination goes back to 1974.

22 It was in this year that an *American marriage ministries* known as the Universal
23 Life Church (ULC) sued the United States Federal Government (in a case known
24 as "The Universal Life Church, Inc. v. The United States of America".) as a
response to an Internal Revenue Service initiated challenge on the ULC's tax
exempt status. The ULC proves to be a non-denominational and non-traditional
church. The court eventually ruled in favor of the ULC church. Although this ULC

1 does not turn out to be a Christian outfit, its victory and the resulting ruling lent
2 great support to the mainstream Christian church in America.

3 Dkt. No. 147-22 at 1 (emphasis added). On its webpage, [www.themonastery.org/training/](http://www.themonastery.org/training/ordination/what-is-ordination)
4 ordination/what-is-ordination, ULC Monastery states:

5 The ULC MONASTERY ordains for life for free. Each denomination has its own
6 special requirements that its ministers comply with or perform to gain their
7 allegiance. The Universal Life Church, an *American marriage ministries*, is the
8 only denomination in the world that opens its door to all and welcomes all who ask
9 for ordination and grants it without questions as to beliefs, grants ordination for life
10 and for free. We make no religious hurdles, no hoops to jump through, no tests of
11 loyalty, no rings to kiss and no fees to pay. Why? The ULC MONASTERY
represents freedom and to have freedom you cannot make demands upon
individuals. When people make demands upon others, there exists a hierarchy;
someone is higher and someone is lower, someone is better and someone is lesser.
The ULC MONASTERY does not act in that manner. In the ULC MONASTERY
everyone is equal -- the same level of greatness is enjoyed by all. That is difficult
for many to understand in a world filled with bosses and employees, haves and have
not's, ordained and not ordained.

12 Dkt. No. 147-23 at 2 (emphasis added).

13 Also, in 2018, ULC Monastery embedded AMM's mark in the title tags and other
14 metatags of its webpages. *See* Dkt. Nos. 147-19 at 1; 149 at 2–3. Although the tags were not
15 visible to users, they would be visible to online search engine algorithms. *See* Dkt. No. 77 at 9.

16 [REDACTED]

17 [REDACTED]

18 [REDACTED]. Undated internal ULC Monastery messages state that it “would
19 be fun” to create three new informational webpages which use “american marriage ministries”
20 and “american ministries” as “generic terms” to try to “chip away a bit at them.” Dkt. No. 147-16
21 at 1. AMM alleges ULM Monastery's actions caused “an abrupt drop in its numbers of ordained
22 ministers and its revenue.” Dkt. No. 199 at 6 (citing Dkt. No. 115-1 at 23–24).

1 In 2019, ULC Monastery conducted a consumer survey showing that, of the 300 people
2 surveyed, only 23.33% associated “American Marriage Ministries” with a single organization or
3 business. Dkt. No. 115-5 at 5-21.

4 Earlier in the case, ULC Monastery moved for summary dismissal of all AMM’s
5 counterclaims, including AMM’s common law trademark infringement and CPA claims. *See*
6 Dkt. Nos. 114, 119, 125. The Honorable Robert S. Lasnik, United States District Judge,
7 dismissed AMM’s state common law trademark and CPA claims, among other things, to the
8 extent they arose from ULC Monastery’s use of the americanmarriageministries.com domain
9 name between 2011 and 2015. Dkt. No. 170 at 2, 13. But Judge Lasnik allowed AMM’s other
10 claims to proceed, including its state common law trademark and CPA claims based on ULC
11 Monastery’s conduct within the applicable statutory limitation periods. *Id.* Judge Lasnik held
12 AMM’s state law trademark claim was subject to a three-year statute while AMM’s CPA claim
13 was subject to a four-year limitations period. *Id.* at 2, 12.

14 On review of AMM’s motion seeking summary judgment on its common law trademark
15 and CPA claims, this Court will observe the law of the case doctrine and consider only ULC
16 Monastery’s alleged infringement since 2018 because its older allegedly infringing conduct is no
17 longer timely. *See United States v. Jingles*, 702 F.3d 494, 499 (9th Cir. 2012) (“Under the ‘law
18 of the case’ doctrine, a court is ordinarily precluded from reexamining an issue previously
19 decided by the same court . . . in the same case.”).

20 AMM also seeks an injunction that prohibits ULC Monastery from ever using
21 “AMERICAN MARRIAGE MINISTRIES.”

DISCUSSION

I. Legal standard.

“A grant of summary judgment is appropriate when there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” *Frlekin v. Apple, Inc.*, 979 F.3d 639, 643 (9th Cir. 2020) (quoting *Mayes v. WinCo Holdings, Inc.*, 846 F.3d 1274, 1277 (9th Cir. 2017)). When evaluating a summary judgment motion, “[t]he evidence is viewed ‘in the light most favorable to the non-moving party.’” *Id.* (quoting *Albino v. Baca*, 747 F.3d 1162, 1168 (9th Cir. 2014)).

II. Disputed issues of material fact preclude summary judgment on AMM’s common law trademark counterclaim.

“Under Washington law, a plaintiff in a trade name infringement case must establish the defendant has infringed on a distinctive feature of [their] name in a manner that tends to confuse the two businesses in the public mind.” *Seattle Endeavors, Inc. v. Mastro*, 868 P.2d 120, 124 (Wash. 1994). The Court reviews the distinctiveness of AMM’s mark and the likelihood of confusion below.

A. There are factual disputes surrounding the distinctive nature of AMM’s mark.

AMM argues again and again that it used the “AMERICAN MARRIAGE MINISTRIES” mark first, but simply consulting a calendar will not resolve this dispute, as the Court must consider whether AMM had an appropriable mark. Trade names “fall along a spectrum of distinctiveness which determines whether the marks are eligible for trademark protection at all, and if so, what the appropriate scope of that protection should be.” *Id.* This spectrum ranges, “least to most appropriable,” from “(1) generic terms; (2) descriptive terms; (3) suggestive terms; and (4) arbitrary or fanciful terms.” *Id.* The first step in analyzing a common law trademark infringement claim is to “locat[e] the mark on the spectrum of distinctiveness,” and second, to

1 assess secondary meaning, or the “strength of the mark in the marketplace, i.e., the extent to
2 which the mark is effective in distinguishing the product or service from others in the relevant
3 area.” *Id.*

4 AMM argues its trade name is “suggestive.” “A word mark which suggests, but does not
5 directly and immediately describe, some aspect of the goods or services is put into the
6 ‘suggestive’ category.” 2 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §
7 11:62 (5th ed. 2023); *see Seattle Endeavors, Inc.*, 868 P.2d at 123 (citing *McCarthy* § 11,
8 generally, with approval). “[S]uggestive marks . . . are viewed as having some level of inherent
9 distinctiveness,” and thus, courts need not analyze whether they carry secondary meaning.
10 *Nordstrom, Inc. v. 7525419 Canada Inc.*, No. C12-1387-TSZ, 2012 WL 12507605, at *6 (W.D.
11 Wash. Dec. 27, 2012). AMM claims its mark is suggestive because it is in the business of
12 “enabling individuals in the U.S. to solemnize marriages,” and not providing spiritual guidance
13 to married couples. *See* Dkt. No. 199 at 15.

14 ULC Monastery counters that AMM’s mark is merely descriptive of AMM’s services. “A
15 ‘descriptive’ term is one that directly and immediately conveys some knowledge of the
16 characteristics of a product or service.” 2 J. McCarthy, *McCarthy on Trademarks and Unfair*
17 *Competition* § 11:16 (5th ed. 2023). Descriptive terms “are more difficult to protect as
18 trademarks because they may already be in use in similar fields and thus not be very ‘distinctive’
19 at all. In this sense they are ‘weak.’” *Seattle Endeavors, Inc.*, 86 P.2d at 124.

20 Although descriptive names are not inherently distinctive, they may still be eligible for
21 protection if they have acquired a secondary meaning or significance by reason of their original
22 and long use. *See Groceteria Stores Co. v. Tibbett*, 101, 162 P. 54, 55 (1916). “Secondary
23 meaning is association, nothing more. . . . That is, that the words, though primarily belonging to
24 the public, have been associated with one’s business in such way and for such length of time that

1 they are generally understood by the public as referring to that one's business.” *Foss v.*
 2 *Culbertson*, 136 P.2d 711, 718 (1943) (internal quotation marks omitted). Here, AMM argues
 3 that even if its mark is only descriptive, it has acquired secondary meaning and thus still warrants
 4 protection.

5 So the questions before the Court on summary judgment are whether a reasonable juror
 6 could find that AMM’s mark was merely descriptive, as ULC Monastery argues, and if so,
 7 whether a reasonable juror could find that AMM’s mark lacked secondary meaning at the time of
 8 ULC Monastery’s alleged infringement.

9 To start, the Court finds a reasonable juror could view AMM’s mark as descriptive, as
 10 opposed to suggestive, because, as the PTO determined in denying AMM’s initial Lanham Act
 11 registration, “the applied-for mark is primarily geographically descriptive of the origin of
 12 [AMM’s] services,” “the term MARRIAGE MINISTRIES merely describes the basic nature of
 13 [AMM’s] services,” and thus lacks inherent distinctiveness. Dkt. No. 115-3 at 44. Whether
 14 AMM’s mark is descriptive or suggestive is a question for the jury. Indeed, “the line between
 15 descriptive and suggestive marks is elusive,” as “legions of trademark lawyers can stay busy
 16 arguing how marks . . . should be categorized.” *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th
 17 1150, 1162 (9th Cir. 2021). For this reason, ““which category a mark belongs in is a question of
 18 fact.”” *Id.* (quoting *Zobmondo Ent., LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir.
 19 2010)).

20 Next, the Court finds that a reasonable juror could find that AMM’s mark failed to
 21 acquire secondary meaning before ULC Monastery’s infringing use. AMM cannot carry its
 22 burden on summary judgment to show otherwise.¹ *See Levi Strauss & Co. v. Blue Bell, Inc.*, 778

23
 24 ¹ AMM continuously refers to secondary meaning as an “affirmative defense” that ULC
 Monastery bears the burden of proving. This is incorrect. AMM is required to establish

1 F.2d 1352, 1358 (9th Cir.1985) (en banc). “[T]he question of secondary meaning is one of fact.”
 2 *Id.* at 1355. In support of its claim, AMM argues that its federal trademark registration carries a
 3 rebuttable presumption that its mark is distinctive and that ULC Monastery failed to rebut this
 4 presumption.² It also cites its Executive Director Lewis King’s declaration, which states AMM
 5 has used its mark to “advertise extensively” and “[h]undreds of thousands of individuals have
 6 obtained AMM’s services under the mark.” Dkt. No. 199 at 21 (citing Dkt. No. 200 at 2). ULC
 7 Monastery rebuts this evidence with a consumer survey showing that, of the 300 people
 8 surveyed, only 23.33% associated “American Marriage Ministries” with a single organization or
 9 business. *See* Dkt. No. 115-5 at 5–21.

10 On this point, however, the court has already held “there [was] a genuine issue of
 11 material fact regarding distinctiveness [i.e., secondary meaning] in the period preceding
 12 registration” because neither the PTO’s finding in 2016 nor the 2019 consumer survey provided
 13 by ULC Monastery provided “conclusive proof of the mark’s association with AMM in the
 14 public mind” *before* ULC Monastery began using the mark. *Id.* at 9–10. AMM relies upon the
 15 same evidence of its mark’s secondary meaning during this time as before, and provides the
 16

17 secondary meaning of its mark for the Court to conclude it justifies trademark protection. *See*
 18 *Flynn v. AK Peters, Ltd.*, 377 F.3d 13, 19 (1st Cir. 2004) (“[T]he individual seeking protection
 19 for a mark bears the burden of proving that secondary meaning has attached within the relevant
 class of consumers.”).

20 ² Without citing any authority, ULC Monastery argues “there is no presumption of validity for a
 21 common law trademark claim.” Dkt. No. 212 at 15. Courts have generally held, however, that
 22 state trademark common law is “given the same meaning and interpretation as the mainstream
 23 principles of federal trademark law.” *See* 3 J. McCarthy, McCarthy on Trademarks and Unfair
 24 Competition § 22:1.5 (5th ed. 2023). In any event, the Court need not expound upon the issue
 beyond its prior ruling, *see* Dkt. No. 170 at 9, because any presumption of validity that flows
 from registration is rebuttable. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir.
 2002) (“In trademark terms, the registration is not absolute but is subject to rebuttal.”). And as
 explained below, questions of fact challenge AMM’s entitlement to summary judgment and any
 presumption of validity.

1 Court nothing new to consider on this latest round of dispositive motion practice.³ Thus, the
2 Court's prior finding of a preregistration dispute as to distinctiveness precludes summary
3 judgment in AMM's favor. The fact that AMM seeks affirmative summary judgment on its
4 counterclaim this time around rather than defending against ULC Monastery's summary
5 judgment motion operates with perhaps more force here given that AMM carries the burden of
6 proving that its mark obtained secondary meaning before ULC commenced its allegedly
7 infringing activities in 2011 and 2014. *See Yellow Cab Co. of Sacramento v. Yellow Cab of Elk*
8 *Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005) ("[I]n an infringement case involving an
9 unregistered mark, the plaintiff has the burden of proof to show that the mark is valid and not
10 generic.").

11 Moreover, even if the Court were to assume *arguendo* that distinctiveness should be
12 measured post-registration in 2018, as AMM implies in its motion, but does not argue outright,
13 the same factual issues would persist. Although the 2019 consumer survey recorded public
14 perceptions after ULC Monastery had been using the mark for around one year, this context goes
15 to the weight of the evidence; the date is not so removed from the subject matter of this suit as to
16 totally invalidate its probative value. *See Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A.,*
17 *Inc.*, 909 F.3d 1110, 1123 (Fed. Cir. 2018) ("Surveys that are conducted within five years of the
18 relevant date may provide evidence as to secondary meaning although no single factor is
19 determinative.") (internal quotation marks omitted).

21
22 ³ In response to ULC Monastery's motion for summary judgment, AMM previously argued its
23 mark acquired secondary meaning, citing its registration with the PTO, "evidence that it has
24 ordained hundreds of thousands of ministers under its mark and that it has engaged in significant
and consistent use of the mark to identify and advertise its services since 2009." Dkt No. 119 at
19. AMM makes the same arguments in its motion for affirmative summary judgment. *See* Dkt.
No. 199 at 21.

1 Accordingly, questions of material fact about distinctiveness and secondary meaning
2 preclude summary judgment on AMM’s common law trademark infringement claim. The jury
3 should decide these questions.

4 B. Genuine issues of material fact exist regarding the likelihood of confusion.

5 ULC Monastery argues its use of AMM’s mark in title tags and metatags qualifies as
6 mere diversion rather than likely confusion. Dkt. No. 212 at 18 (citing *Network Automation Inc.*
7 *v. Advanced Sys. Concepts Inc.*, 638 F.3d 1137, 1149 (9th Cir. 2011) and *Multi Time Mach., Inc.*
8 *v. Amazon.com, Inc.*, 804 F.3d 930, 935 (9th Cir. 2015)). AMM argues ULC Monastery omits
9 the fact that ULC Monastery claimed to be “an American Marriage Ministries” on its websites,
10 which differs from “the ‘mere diversion’ examples that [ULC Monastery] pretends this case
11 exclusively to be.” Dkt. No. 221 at 9. AMM further argues this use “is sufficient for summary
12 judgment” on the likelihood of confusion, without considering ULC Monastery’s use of AMM’s
13 mark in title tags and metadata. *Id.*

14 The Court examines the “likelihood of confusion” through the *Sleekcraft* factors, “which
15 are a proxy for consumer confusion, not a rote checklist.” *Bio Mgmt. Nw. Inc. v. Washi. Bio*
16 *Servs.*, No. C20-670 MJP, 2021 WL 4319448, at *2 (W.D. Wash. Sept. 23, 2021) (quoting
17 *Network Automation, Inc.*, 638 F.3d at 1145).⁴ “These factors are neither exhaustive nor
18 dispositive.” *Id.* (citing *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1160 (9th Cir.
19 2021)). “The presence or absence of a particular factor does not necessarily drive the
20 determination of a likelihood of confusion.” *Id.* (citing *E. & J. Gallo Winery v. Gallo Cattle Co.*,
21 967 F.2d 1280, 1290 (9th Cir. 1992)).

22
23 ⁴ Courts have applied the *Sleekcraft* factors to assess the likelihood of confusion in Washington
24 common law trademark suits. See *David N. Brown, Inc. v. Act Now Plumbing, LLC*, 170 Wn.
App. 1045, 2012 WL 4335922, at *2 (2012) (unpublished); *Bio Mgmt. Nw. Inc.*, No. C20-670
MJP, 2021 WL 4319448, at *2.

Here, the Court considers the following relevant factors: (1) the strength of AMM's mark, (2) the relatedness of AMM and ULC Monastery's services, (3) the similarity of the marks in use, (4) evidence of actual confusion, (5) marketing channels used, and (6) evidence of ULC Monastery's intent while using the mark. *See AMF Inc. v. Sleekcraft Boats*, 599 F.2d 342, 348–49 (9th Cir. 1979). Courts should not grant summary judgment where “conflicting facts render it unclear whether a likelihood of confusion exists.” *Id.* at 1161–62.

That AMM and ULC Monastery provide largely the same services and reach consumers through the same online marketing channels, as well as the fact that ULC Monastery referred to itself as “an American Marriage Ministries” all favor a likelihood of confusion. Additionally, there is evidence in the record for a jury to find that ULC Monastery knowingly used AMM's mark to “chip away at it.” *See* Dkt. No. 147-16 at 1. Notwithstanding these factors, disputed facts regarding distinctiveness and the strength of AMM's mark, render it unclear whether the likelihood of confusion exists and make summary judgment inappropriate. Moreover, although not required, AMM fails to provide evidence of actual confusion, which also weighs against summary judgment.

C. ULC Monastery has not established a nominative fair use defense, but it has provided evidence sufficient to present a classic fair use defense to the jury.

AMM asks the Court to dismiss ULC Monastery's nominative and classic fair use defenses. Dkt. No. 199 at 22. Although both classic and nominative fair use defenses qualify as non-infringing conduct, they are fundamentally different:

The nominative fair use analysis is appropriate where a defendant has used the plaintiff's mark to describe the plaintiff's product, *even if the defendant's ultimate goal is to describe his own product*. Conversely, the classic fair use analysis is appropriate where a defendant has used the plaintiff's mark *only* to describe his own product, *and not at all to describe the plaintiff's product*.

Cairns v. Franklin Mint Co., 292 F.3d 1139, 1151 (9th Cir. 2002) (emphasis in original).

1 AMM claims, because ULC Monastery’s optimized webpages “explicitly assert that
2 [ULC Monastery] is an ‘American marriage ministry,’” there is no credible argument that ULC
3 Monastery is referring to AMM. Dkt. No. 199 at 22. ULC Monastery does not directly address
4 AMM’s argument but cites to Judge Lasnik’s order, which states “certain uses to which ULC
5 [Monastery] put AMM’s mark simply communicated ideas regarding AMM or expressed points
6 of view that required the use of AMM’s name (*e.g.*, the publication of a legal ruling regarding
7 AMM)” but other uses “implicated the source-identification function of the mark by intentionally
8 blurring AMM’s association with ULC Monastery and/or its mark.” Dkt. No. 212 at 20 n.10
9 (citing Dkt. No. 170 at 10). For these reasons, Judge Lasnik held ULC Monastery did not show it
10 was entitled to dismissal of any of AMM’s claims based on non-infringing uses. Dkt. No. 170 at
11 10.

12 Here, the Court finds ULC Monastery cannot sustain a nominative fair use defense for its
13 common law trademark claim given that all potentially nominative uses occurred before the
14 statute of limitations and have therefore been dismissed. AMM’s common law trademark claim
15 is based on ULC Monastery’s conduct since 2018—i.e., optimizing its websites by embedding
16 AMM’s mark in its title tags and metadata, and explicitly referring to ULC Monastery as “an
17 American marriage ministries.” None of this conduct qualifies as nominative fair use, nor was it
18 the conduct referenced by Judge Lasnik in his prior order. Thus, the Court DISMISSES ULC
19 Monastery’s nominative fair use defense to the extent it applies to AMM’s common law
20 trademark claim.

21 For a classic fair use defense, defendants must establish three elements: (1) their “use of
22 the term is not as a trademark or service mark;” (2) they use “the term ‘fairly and in good faith’”;
23 and (3) their use is “only to describe its goods or services.” *Cairns*, 292 F.3d at 1151 (internal
24 quotation marks omitted). ULC Monastery argues there is a genuine dispute of material fact

1 regarding whether its uses of AMM's mark were descriptive and in good faith. Dkt. No. 212 at
2 21–22. ULC Monastery cites the Rule 30(b)(6) deposition of Glen Yoshika in which the ULC
3 Monastery founder testified that it referred to itself as an American marriage ministries on its
4 websites “generically” and for the purpose of increasing Google search rankings when people
5 searched for American marriage ministries. *See* Dkt. Nos. 117-3 at 2; 115-2 at 57. Whether ULC
6 Monastery's explanation qualifies as a good faith, descriptive use of AMM's mark is a question
7 of fact for the jury to decide. Therefore, the Court denies summary judgment dismissal of ULC
8 Monastery's classic fair use defense.

9 **III. The Court declines to grant summary judgment on AMM's CPA counterclaim.**

10 AMM argues ULC Monastery “must be found liable for its unfair and deceptive practices
11 as a matter of law” even if the amount in damages presents a question of fact. Dkt. No. 199 at 17.
12 A private party must show the following five elements to establish a violation of the CPA: “(1)
13 an unfair or deceptive act or practice; (2) occurring in the conduct of trade or commerce; (3)
14 affecting the public interest; (4) injuring the plaintiff's business or property; and (5) a causal link
15 between the unfair or deceptive act and the injury suffered.” *Seattle Endeavors, Inc.*, 868 P.2d at
16 126.

17 Because both require a plaintiff to establish likelihood of confusion, a successful trade
18 name infringement claim may serve as the basis for a CPA claim. *See id.* at 127. Given that the
19 Court found disputed issues of material fact as to the distinctiveness of AMM's trade name and
20 the likelihood of confusion caused by ULC Monastery's use, summary judgment should be
21 denied as to AMM's CPA claim.

22 **CONCLUSION**

23 Accordingly, the Court GRANTS AMM's motion in part and DISMISSES ULC
24 Monastery's nominative fair use defense to the extent it applies to AMM's common law

1 trademark claim. The Court DENIES AMM's motion for partial summary judgment on its
2 common law trademark and CPA counterclaims in all other respects not addressed in the court's
3 previous orders.

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5 Dated this 18th day of August, 2023.

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7 _____
8 Jamal N. Whitehead
9 United States District Judge
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